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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/791,864

03/04/2004

Wen Hsiang Yuch

MR1957-858

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4586

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08/09/2007

ROSENBERG, KLEIN & LEE

3458 ELLICOTT CENTER DRIVE-SUITE 101

ELLICOTT CITY, MD 21043

EXAMINER

MONIKANG, GEORGE C

ART UNIT

PAPER NUMBER

2615

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/791,864

Applicant(s)

YUEH, WEN HSIANG

Examiner

George C. Monikang

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 04 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 7 & 9 (Application No. 10/791,864, hereinafter referred to as '864) are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of patent number 6,968,066 B2 (hereinafter referred to as '066). Although the conflicting claims are not identical, they are not patentably distinct from each other.

The '864 claims 1, 7 & 9 are broader recitations of the same invention claimed in '066 claim 1. Therefore, '066 claim 1 is encompassed by '864 claims 1, 7 & 9. It is critical that patents issuing from these applications be commonly owned to avoid potential licensees from owing license fees to two different parties.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 & 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toda, US Patent Pub. 2003/0028110 A1.

Re Claim 1, Toda discloses an microphone, adhered to a portion of human skin, the portion of human skin slightly vibrating with a speaking voice, and primarily having a membrane sound receiver disposed on an outer sound receiving portion of a main body (para 0023), the membrane sound receiver comprising: a first membrane layer adhered to the outer sound receiving portion of the main body (figs. 2a-2b, 5: 70; para 0023); a second membrane layer adhered to a sound source to acquire a sound signal (figs. 2a-2b: 61 & 62, fig. 5: 60; para 0022); and a sound receiving layer disposed between the first and second membrane layers, the sound receiving layer having at least a sound receiving hole for sound input (figs. 2a-2b, 5: 50; para 0022).

Toda does not explicitly disclose the microphone being an adhesive microphone as claimed. Official notice is taken that both the concepts and advantages of providing a microphone with adhesive capabilities are well known in that art. It would have been obvious to use an adhesive material with the microphone to enhance the microphones ability to make contact with a portion of the human skin.

Re Claim 6, Toda discloses the microphone as claimed in claim 1, wherein the sound source is a neck of the human skin and slightly vibrates with the speaking voice (para 0003).

Claim 7 has been analyzed and rejected according to claim 1.

Re Claim 8, which further recites, "Wherein the membrane sound receiver is a diathermy adhesive plate." Toda does not explicitly disclose a diathermy adhesive as claimed. Official notice is taken that both the concepts and advantages of using diathermy are well known in the art. It would have been obvious to make the adhesive diathermic to relax the muscle of the area while in contact with the microphone.

Re Claim 9, which further recites, "Wherein the membrane sound receiver is a ventilative adhesive plate." Toda does not to explicitly disclose a ventilative adhesive plate a claimed. Official notice is taken that both the concept and advantages of using ventilative materials are well known in the art. It would have been obvious make the adhesive ventilative in order to prevent moisture forming when microphone is in contact with human skin.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2-5 & 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toda, US Patent Pub. 2003/0028110 A1 as applied to claim 1 above, and further in view of Gobeli et al, US Patent Pub. 2004/0114778 A1.

Re Claim 2, Toda discloses the microphone as claimed in claim 1, but fails to disclose further comprising a condenser microphone connected with an amplifying circuit disposed inside the main body, the condenser microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit. However, Gobeli et al does (para 0018).

Taking the combined teachings of Toda and Gorbeli et al as a whole, one skilled in the art would have found it obvious to modify the microphone of Toda with further comprising a condenser microphone connected with an amplifying circuit disposed inside the main body, the condenser microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit as taught in Gobeli et al (para 0018) to improve the tone quality.

Re Claim 3, Toda discloses the microphone as claimed in claim 1, but fails to disclose further comprising a piezoelectric microphone connected with a amplifying circuit disposed inside the main body, the piezoelectric microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit. However, Gobeli et al does (paras 0019 & 0066).

Taking the combined teachings of Toda and Gobeli et al as a whole, one skilled in the art would have found it obvious to modify the microphone of Toda with further comprising a piezoelectric microphone connected with a amplifying circuit disposed

inside the main body, the piezoelectric microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit as taught in Gobeli et al (paras 0019 & 0066) to isolate the microphone from the background noise.

Claim 4 has been analyzed and rejected according to claim 3.

Re Claim 5, Toda discloses the microphone as claimed in claim 1, but fails to disclose further comprising a membrane vibrating microphone connected with a amplifying circuit disposed inside the main body, the membrane vibrating microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit. However, Gobeli et al does (para 0003).

Taking the combined teachings of Toda and Gobeli et al as a whole, one skilled in the art would have found it obvious to modify the microphone of Toda with further comprising a membrane vibrating microphone connected with a amplifying circuit disposed inside the main body, the membrane vibrating microphone used to receive the sound signal and amplifying and outputting the sound signal via the amplifying circuit as taught in Gobeli et al (para 0003) to make the sound from the microphone more understandable.

Claim 10 has been analyzed and rejected according to claim 2.

Claim 11 has been analyzed and rejected according to claim 3.

Claim 12 has been analyzed and rejected according to claim 3.

Claim 13 has been analyzed and rejected according to claim 5.

**Contact**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Monikang whose telephone number is 571-270-1190. The examiner can normally be reached on M-F. alt Fri. Off 7:30am-5:00pm (est).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chin Vivian can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George Monikang

8/4/2007

  
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